

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Jason M. English, et al. Art Unit 3761
Serial No. 10/719,613
Filed November 21, 2003
Confirmation No. 3131
For LABIAL PAD
Examiner Michael D. Bogart

February 13, 2008

REPLY BRIEF

This is a reply to the Examiner's Answer mailed December 28, 2007. Appellants' reply is being filed to respond to Grounds of Rejection being presented for the first time in the Examiner's Answer. In particular, the Office raises for the first time a reliance on *In re Wertheim*, 541 F.2d 257. 191 USPQ 90 (CCPA 1976) to support its position.

Specifically, with respect to claims 1-3 and 41, the Office for the first time relies on *In re Wertheim* for the proposition that when the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. More specifically, the Office takes the position that because Bewick discloses that the storage core disclosed therein can contain between 25% and 100% fibrous superabsorbent material, such a disclosure renders claims 1 and 41 *prima facie* obvious - purportedly because these claims include a recitation that the absorbent structure comprises in the range of about 5 weight percent to about 35 weight percent superabsorbent material. See pages 6 and 8 of the Examiner's Answer.

Appellants note, however, that in *In Re Wertheim* each of the features of the claims at issue were present in the cited references other than claimed range limitation. In the present case, the absorbent structure of claims 1 and 41 is

not comprised solely of the recited range of superabsorbent material concentration. There are a number of additional recitations in claims 1¹ and 41² (as discussed in appellants' Amended Appeal Brief) that are neither expressly nor inherently disclosed in Bewick or the other cited references. The fact that Bewick discloses a range of superabsorbent material concentration that partially overlaps the superabsorbent material concentration recited in claims 1 and 41 neither renders the remaining elements recited in these claims *prima facie* obvious nor does it render them inherent.

Accordingly, the Office's reliance on *In re Wertheim* is asserted to be unsupported of its position regarding claims 1 and 41.

With respect to claim 24, appellants note that in *In re Wertheim*, the court found that when the prior art (Pfluger 1963) disclosed a range for a foam density between about 0.1 and 0.5 gm/cc, the prior art actually taught away from foams having a density outside of the disclosed range (between 0.6 and 0.8 gm/cc). The same situation is present in the case at

¹ E.g., said superabsorbent material having a gel stiffness index of at least about 0.5, said absorbent structure having a saturation capacity as determined by a Saturation Capacity and Retention Capacity Test of at least about 15 grams/gram, a retention capacity as determined by said Saturation Capacity and Retention Capacity Test of at least about 3 grams/gram, and an intake time for a first insult of said absorbent structure as determined by an Intake and Rewet Test of no more than about 30 seconds

² E.g., said absorbent structure having a basis weight in the range of about 150 to about 400 grams per square meter and a density in the range of about 0.05 to about 0.13 grams per cubic centimeter, said absorbent structure having an intake time for a first insult of said absorbent structure as determined by an Intake and Rewet Test of no more than about 30 seconds

hand. Bewick discloses that the storage core disclosed therein can contain between 25% and 100% fibrous superabsorbent material. See paragraph [0114] of Bewick. However, claim 24 recites that the absorbent structure comprises superabsorbent material in the range of about 5 weight percent to about 15 weight percent, which is clearly outside of the range disclosed by Bewick. Following the holding in *In re Wertheim*, Bewick arguably teaches away from the range of superabsorbent material recited in claim 24.

For these additional reasons, claim 24 is further submitted to be patentable over Bewick and the other cited references.

Conclusion

In addition to the reasons set forth in the appellants' Amended Appeal Brief, the rejections of the claims on appeal are submitted to be in error for the reasons set forth above.

Appellants do not believe that any fee is due. However, the Commissioner is hereby authorized to charge any deficiency or overpayment of any fees to Deposit Account No. 12-384.

Respectfully submitted,

/Richard L. Bridge/

Richard L. Bridge, Reg. No. 40,529
ARMSTRONG TEASDALE LLP
One Metropolitan Square, 26th Floor
St. Louis, Missouri 63102
(314) 621-5070

RLB/PEB/tmg
Via EFS